

### **REMARKS/ARGUMENTS**

Applicants have carefully reviewed the Office Action mailed on July 23, 2008. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1, 3, 4, 6-15, 17-54, and 61-67 are pending. Claims 23-54, 61, and 62 have been previously withdrawn. With this paper, claims 1, 14, and 67 have been amended. Support for the amendments may be found in the specification, claims, and drawings as originally filed. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

#### **Claim Rejection under 35 U.S.C § 103**

On page 2 of the Office Action, claims 1, 3-4, 12-15, 17, 22, and 63-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935). Applicants respectfully traverse this rejection.

Independent claim 1, as amended, recites:

1. (Currently Amended) A guidewire, comprising:
  - a core member having a proximal end and a distal end, wherein the core member is generally solid in cross-section;
  - a metallic tubular member having a proximal end and a distal end and a lumen therebetween, the tubular member connected to the distal end of the core member, the distal end of the core member disposed in the lumen of the tubular member and the distal end of the tubular member extending distally beyond the distal end of the core member; and
  - a coil member connected to and disposed about the tubular member;
- wherein the coil member includes a distal end and a proximal end, and wherein the distal end of the coil member extends distally beyond the distal end of the tubular member,
- wherein the coil member has an outer diameter and wherein the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member.

Bonello et al. do not appear to teach or suggest such a device. On page 2 of the Office Action, the Examiner asserts:

- In regards to claim 1, Bonello et al. discloses a guidewire, comprising:  
a core member 1 having a proximal end and a distal end;

a tubular member 3 having a proximal end and a distal end and a lumen therebetween, the tubular member 3 disposed about and connected to the distal end of the core member 1, the distal end of the tubular member 3 extending distally beyond the distal end of the core member 1; and  
a coil member 2 connected to a disposed about the tubular member 3;  
wherein the coil member 2 includes a distal end and a proximal end, and  
wherin the distal end of the coil member 2 extends distally beyond the distal end of the tubular member 3 (see figs. 1-2).

Bonello et al. do not appear to teach or suggest the distal end of the core member is disposed in the lumen of the tubular member as currently claimed as asserted by the Examiner. Bonello et al. teach at column 1, lines 38-43, "The remote controlled guide for a catheter shown in the drawing comprises a tube 1 at the end of which is mounted coaxially the head of the catheter guide, formed of a cylindrical coil spring 2, the base of which is fitted onto a pierced piece 3 itself driven within the tube 1." Bonello et al. clearly teach the pierced piece 3, which the Examiner has equated with the presently claimed metallic tubular member, is disposed within the tube 1. As can further be seen in Figures 1 and 2 of Bonello et al., tube 1 is not disposed in pierced piece 3. Thus, Bonello et al. cannot be considered as teaching or suggesting the distal end of the core member is disposed in the lumen of the tubular member as currently claimed.

Further, Bonello et al. do not appear to teach or suggest the core member is generally solid in cross-section as currently claimed. Bonello et al. appear to teach a remote controlled guide for a catheter operated by a user pulling on a proximal portion of a flexible pulling member. Bonello et al. appear to teach a flexible pulling member 5 is disposed within tubular member 1 and attached to an end piece 4. There appears to be no motivation, suggestion, or other reason for Bonello et al. to modify the device such that the core member is generally solid in cross-section as currently claimed as it would render the device inoperable for its intended use as the flexible pulling member is necessary in Bonello et al., but not possible with a solid cross-section.

The Examiner has relied on Gambale to teach that which Bonello et al. lack. However, it appears that if one were to combine the teachings of Gambale with Bonello et al., it would render the device of Bonello et al. non-functional. MPEP 2143.01 V states, "If proposed modification would render the prior art invention being modified unsatisfactory for

its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” Thus, even if one were to combine the teachings Bonello et al. and Gambale, one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Bonello et al. or Gambale to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. Applicants submit that claims 3, 4, 12, and 13 are also in condition for allowance as they depend from claim 1 and add significant limitations to further distinguish them from the prior art.

Turning now to independent claim 14, which recites:

14. (Currently Amended) A guidewire comprising:
- a core member including a proximal portion having a proximal end and a distal portion having a distal end, wherein the core member is generally solid in cross-section; and
  - a distal assembly including a metallic tubular member having an inner surface adapted for connection to the distal portion of the core member, and an outer surface, and a coil member connected to the tubular member;
    - wherein the distal assembly is connected to the distal portion of the core member such that a portion of the distal assembly extends distally beyond the distal end of the core member;
    - wherein the coil member includes a distal end and a proximal end, and wherein the distal end of the coil member extends distally beyond a distal end of the tubular member,
    - wherein the coil member has an outer diameter and wherein the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member.

Bonello et al. do not appear to teach or suggest a metallic tubular member having an inner surface adapted for connection to the distal portion of the core member. Additionally, in formulating the rejection, the Examiner asserts:

In regards to claim 14, Bonello et al. discloses a guidewire comprising:  
A core member 1 including a proximal portion having a proximal end and a distal portion having a distal end; and  
a distal assembly (2,3) including a tubular member 3 having an outer surface adapted for connection to the distal portion of the core member 1, and an outer surface, and a coil member 2 connected to the tubular member 3;

wherein the distal assembly (2,3) is connected to the distal portion of the core member 1 such that a portion of the distal assembly extends distally beyond the distal end of the core member 1 (see figs. 1-2).

Emphasis added. As acknowledged by the Examiner, Bonello et al. clearly does not appear to teach or suggest a metallic tubular member having an inner surface adapted for connection to the distal portion of the core member.

Further, Bonello et al. do not appear to teach or suggest the core member is generally solid in cross-section as currently claimed. Bonello et al. appear to teach a remote controlled guide for a catheter operated by a user pulling on a proximal portion of a flexible pulling member. Bonello et al. appear to teach a flexible pulling member 5 is disposed within tubular member 1 and attached to an end piece 4. There appears to be no motivation, suggestion, or other reason for Bonello et al. to modify the device such that the core member is generally solid in cross-section as currently claimed as it would render the device inoperable for its intended use as the flexible pulling member is necessary in Bonello et al., but not possible with a solid cross-section.

The Examiner has relied on Gambale to teach that which Bonello et al. lack. However, it appears that if one were to combine the teachings of Gambale with Bonello et al., it would render the device of Bonello et al. non-functional. Thus, even if one were to combine the teachings Bonello et al. and Gambale, one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Bonello et al. or Gambale to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. Applicants submit that claims 15, 17, 22, 65, and 66 are also in condition for allowance as they depend from claim 14 and add significant limitations to further distinguish them from the prior art.

Turning now to independent claim 67, which recites:

67. (Currently Amended) A guidewire, comprising:  
a metallic core member having a proximal end and a distal end,  
wherein the core member is generally solid in cross-section;  
a metallic tubular member having a proximal end and a distal end  
disposed about and attached to the distal end of the core member; and  
a metallic coil member disposed about and attached to the distal end of  
the tubular member,

wherein the tubular member has a uniform inner diameter and a uniform outer diameter and wherein the distal end of the core member where the tubular member is attached has an outer diameter that is less than the inner diameter of the tubular member and wherein the coil member has an inner diameter that is greater than the outer diameter of the tubular member, and

wherein the tubular member extends distally beyond the distal end of the core member and the coil member extends distally beyond the distal end of the tubular member.

Bonello et al. do not appear to teach or suggest a metallic tubular member having a proximal end and a distal end disposed about and attached to the distal end of the core member. As can be seen in Figures 1 and 2, Bonello et al. appear to teach the pierced piece 3 is disposed within tube 1. Thus, Bonello et al. clearly does not appear to teach or suggest a metallic tubular member having a proximal end and a distal end disposed about and attached to the distal end of the core member.

Further, Bonello et al. do not appear to teach or suggest the core member is generally solid in cross-section as currently claimed. Bonello et al. appear to teach a remote controlled guide for a catheter operated by a user pulling on a proximal portion of a flexible pulling member. Bonello et al. appear to teach a flexible pulling member 5 is disposed within tubular member 1 and attached to an end piece 4. There appears to be no motivation, suggestion, or other reason for Bonello et al. to modify the device such that the core member is generally solid in cross-section as currently claimed as it would render the device inoperable for its intended use as the flexible pulling member is necessary in Bonello et al., but not possible with a solid cross-section.

The Examiner has relied on Gambale to teach that which Bonello et al. lack. However, it appears that if one were to combine the teachings of Gambale with Bonello et al., it would render the device of Bonello et al. non-functional. Thus, even if one were to combine the teachings Bonello et al. and Gambale, one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Bonello et al. or Gambale to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

On page 5 of the Office Action, claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) and in further view of Richardson et al. (U.S. Patent No. 6,673,025).

On page 6 of the Office Action, claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) and in further view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 6 of the Office Action, claims 9-10 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) and in further view of Cook et al. (U.S. Patent No. 5,213,111).

On page 7 of the Office Action, claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) in view of Cook et al. (U.S. Patent No. 5,213,111) and further in view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 7 of the Office Action, claims 18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) and further in view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 8 of the Office Action, claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonello et al. (U.S. Patent No. 4,732,163) in view of Gambale (U.S. Patent No. 5,063,935) and further in view of Buchbinder et al. (U.S. Patent No. 4,815,478). Applicants respectfully traverse this rejection.

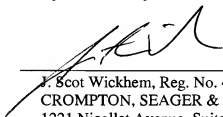
For at least the reasons discussed above independent claims 1 and 14, from which the above claims depend, are believed patentable over the combination of Bonello et al. and Gambale. None of Richardson et al., Cook et al., Palmer et al., and Buchbinder et al., appears to teach that which Bonello et al. and Gambale lack. Thus, the cited references neither alone nor in combination appear to teach or suggest the claimed invention. Reconsideration and withdrawal of the rejections are respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
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By their attorney,

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